

### REMARKS

This is in response to the Office Action mailed on February 20, 2004, and the references cited therewith.

Claims 1-3, 6, 9, 23, and 29-32 are amended, no claims are canceled, and claims 37-39 are added; as a result, claims 1-7, 9-18, and 20-39 are now pending in this application.

#### §101 & §112 Rejection of the Claims

Claims 1-2 and 29-32 were rejected under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-2 and 29-32 were rejected under 35 USC § 112, first paragraph, because, according to the Office Action, “current case law (and accordingly, the MPEP) require such a rejection if a 101 rejection is given.”

Applicant has amended claims 1-2 and 29-32 to recite a “computerized method” instead of a “method.” Applicant submits that these amendments overcome the rejections under §§ 101 and 112.

#### §102 Rejection of the Claims

Claims 1-7, 9-17 and 20-24 were rejected under 35 USC § 102(e) as being anticipated by Kohn et al. (U.S. Patent No. 5,963,447; hereinafter referred to as Kohn). Applicant traverses this rejection because Kohn does not anticipate claims 1-7, 9-17, and 20-24.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).



Regarding amended independent claim 1, the Office Action indicates that either Kohn's "general-purpose architecture for incremental construction of provably-correct, near optimal systems for real-time control of small-scale and large-scale systems" (Kohn, col 4, lines 57-62), Kohn's "network of agents" that "support reuse of trusted components of other applications through declarative inclusion into new system architectures" (Kohn, col 6, lines 14-17), or Kohn's Knowledge-base Builder 22 (which supports manual input from users) anticipates the claimed "production recipe." However, Applicant cannot find in the cited passages or elsewhere in Kohn, anything that anticipates a "production recipe."

Additionally, to clarify the invention, Applicant has amended independent claim 1 to recite "wherein the production recipe is for producing a quantity of a product." Support for this amendment can be found in the Instant Application, among other places, at Page 4, Lines 24-25. Applicant knows of no passage in Kohn that anticipates the claimed "producing a quantity of a product."

Applicant has added features similar to those added to independent claim 1 to independent claims 3, 6, 9, and 23. For the reasons discussed above, Applicant respectfully submits that independent claims 1, 3, 6, 9 and 23 are allowable.

Claims 2, 4, 5, 7, 10-17, 20-22, and 24 each depend, directly or indirectly, on one of independent claims 1, 3, 6, 9 or 23 and are allowable for the reasons discussed above.

New claims 37-39 depend from independent claim 1 and are allowable for the reasons discussed above.

For the reasons cited above and elements of the claims, Applicant respectfully submits that Kohn does not teach or suggest each and every element of claims 1-7, 9-17, and 20-24. Therefore, Applicant requests that the rejections be withdrawn and the claims be allowed.

### §103 Rejection of the Claims

Claim 18 was rejected under 35 USC § 103(a) as being unpatentable over Kohn et al. in view of Acknowledged Prior Art (U.S. Patent No. 5,963,447, referred to as Kohn; Specification, referred to as Acknowledged Prior Art, APA). Applicant traverses this rejection because the Office Action has not made a *prima facie* case of obviousness.



The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claim 18 depends on amended independent claim 9. As discussed above, Applicant submits that Kohn does not teach or suggest all of the elements of claim 9. APA does not provide what Kohn is lacking. Therefore, Applicant respectfully submits that the combination of Kohn and APA does not teach or suggest each and every element of dependent claim 18.



*Allowable Subject Matter*

Claims 25-28 and 33-36 were indicated to be allowable. Applicant acknowledges and thanks the Examiner for indicating claims 25-28 and 33-36 are allowable.

*Reservation of Rights*

Applicant does not admit that documents cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such documents should not be construed as admissions that the documents are prior art.



Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 371-2169 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20 day of May, 2004.

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Name

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Signature